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1751

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/443,505
Filing Date: November 19, 1999
Appellant: AUDOUSSET, MARIE-PASCALE

Mareesa A. Frederick
For Appellant

EXAMINER'S ANSWER

MAILED
SEP 21 2004
GROUP 1700

This is in response to the appeal brief filed July 1, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is substantially accurate, however, this office disagrees with applicant's characterization of the invention as unobvious.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The brief states that the rejected claims will stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|------------------|------------------------------|---------------|
| 4,997,451 | <i>Clausen et al.</i> | 3-1991 |
| 5,230,710 | <i>Akram et al.</i> | 7-1993 |
| 6,074,438 | <i>Lim et al.</i> | 6-2000 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3,5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim '438 in view of Akram.

Lim, U.S. Patent No. 6,074,438, teaches and exemplifies compositions for dyeing hair which contain the oxidation base 2-chloro-4-aminophenol and a pyrazolone coupler, see Abstract and Table 1, Composition C. The exemplified composition is mixed with a hydrogen peroxide oxidant as is applied to hair as claimed, see col. 10, line 65-col. 11, line 2. Lim teaches that additional couplers may be added to the compositions in order to obtain certain color nuances and tints, including the claimed 2,6-bis(hydroxyethylamino)toluene [note: this appellant's (b) coupler which is named 1,3-bis(β -hydroxyethyl)amino-2-methylbenzene in this application], as well as direct dyes and additional p-aminophenol oxidation bases as claimed, see col. 5, lines 1-11 and 32-37, and col. 6, line 24. The additional p-amino phenol oxidative bases listed in column 5 lines 32-37 include several which are included in the claimed formula (I): 3-methyl-p-aminophenol, 2-hydroxymethyl-p-aminophenol, 2-methyl-p-aminophenol and 2-methoxymethyl-p-aminophenol. Lim teaches that the compositions may be packaged

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in kits as claimed, see col. 10, lines 46-54. Lim does not exemplify a composition, process or kit as claimed, particularly which contains or uses the claimed coupler, or which additionally comprises the above listed p-aminophenol oxidation bases.

Akram is relied upon above as teaching that the claimed 2,6-bis(hydroxyethylamino) toluene has many improved properties when used as a coupler in hair dyeing compositions. See col 2 lines 24 et seq.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains an oxidation base and coupler as claimed, as well as the claimed additional couplers and direct dyes, wherein each component is present in the claimed amounts, is packaged in kits as claimed, and is applied to hair in dyeing processes as claimed, because such compositions, processes and kits fall within the scope of those as taught by Lim. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed 2,6-bis(hydroxyethylamino)toluene for use as the additional coupler in Lim's compositions because Lim teaches the claimed coupler as being suitable for use in the patentee's compositions, and because Akram teaches that the claimed 2,6-bis(hydroxyethylamino)toluene is preferred and results in various improved dyeing properties such as intense colors and resistance to various agents. Therefore, based upon Akram's teachings, those skilled in the art would have been motivated to select the claimed coupler from among those taught by Lim for use in Lim's compositions, absent a showing otherwise. It would have been obvious to add any or all of the claimed p-aminophenols listed in col 5 in the hair dyeing compositions as

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shown in order to provide a variety of shades of hair and additionally because it is notoriously well known in the hair dyeing art to combine several oxidation bases and couplers in oxidative hair coloring compositions, and the use of the additional bases and couplers falls within Lim's express teachings.

Claims 1-3, 5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim in view of Akram as applied to claims 1-3 and 5-18 above, and further in view of Clausen et al., US 4,997,451. The combination of Lim and Akram as applied above teaches that the claimed substituted p-aminophenol bases are compatible with the claimed coupler when used in oxidation dyeing compositions, and that the claimed coupler has certain advantageous properties which would motivate its selection for use in an oxidative hair dyeing composition. The following reference gives motivation to select one or more of applicant's claimed substituted p-aminophenol bases for use in a hair dyeing composition.

Clausen et al. teach the use of the claimed 4- amino-2-methoxymethylphenol (col 2 lines 5-33) as a preferred embodiment of his improved developers. He gives motivation for using said developer by stating at column 1 lines 38 et seq:

"p-Aminophenol, alone or in a mixture with other developer substances, in combination with suitable coupler substances is especially preferred for producing natural and especially fashionable shades.

Considerations regarding physiological compatibility are currently being raised against the p-Aminophenol developer substances for the red part of the color spectrum, while more recently the developer substances recommended, e.g. pyrimidine derivatives, cannot be completely satisfactory in regard to dyeing.

Much research and development has been aimed at elimination of the disadvantage of poor physiological compatibility of the p-aminophenol developer substances used in the red region.

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Thus oxidative hair dyeing compositions with a content of 4-amino-2-hydroxymethylphenol, which lead only to satisfactory hair color in the red range with a slight improvement relative to p-Aminophenol, are known and described in German Published Patent Applications DE-OS 3 441 148 and DE-OS 3 538 750.

SUMMARY OF THE INVENTION

It is an object of the present invention to provide an oxidative hair dyeing composition based on developer substances for the red range, which is comparable in color intensity and brightness with p-Aminophenol but has improved physiological compatibility."

It would have been obvious to the skilled artisan to select a substituted p-aminophenol for use in oxidative hair dyeing compositions instead of p-aminophenol because p-aminophenol has poor physiological compatibility, and since it has outstanding dyeing properties, a closely related substitute for it is actively sought by hair dyeing chemists. Accordingly, in the above passage, Clausen et al. give motivation to choose 4-amino-2-methoxymethylphenol as well as stating that the claimed 4-amino-2-hydroxymethylphenol is also an improvement over p-aminophenol.

(11) Response to Argument

Appellant's arguments regarding the rejection of the claims as unpatentable over **Lim in view of Akram** have been fully considered but they are not persuasive to overcome the above rejection. Appellant argues that there must be some suggestion in the references to modify the teachings of the references. Lim suggests the combination as claimed as he teaches that both of the components in the claimed compositions are suitable for use together in his disclosed compositions. Applicant states that Lim teaches that developers (1) and (2) may be combined with couplers (3), (4) or (5). See abstract. That is correct. But patentee also teaches that the claimed coupler and base

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may be used together. Appellant's composition are stated in comprising language; in no way do they exclude the additional components of Lim. It is notoriously well known that hair dyeing compositions may contain several dye bases, and Lim teach that the claimed dye base and coupler are suitable for use together in oxidation hair dyeing. Appellant argues that the above statement (i.e., "It is notoriously well known...") is not warranted. Evidence that said statement is indeed true is found in the art of record. Lim not only suggests the addition of a plethora of additional bases and couplers but also exemplifies several each in compositions D and E in col 11. Clausen et al. exemplifies mixtures of six bases and couplers in example 5 and five in example 6 in column 8. Lim teaches that they the claimed bases and coupler are compatible, they have known utility in the same process under the same process conditions. Thus Lim alone is sufficient to provide a teaching that the two claimed components are useable together in oxidative hair dyeing compositions and processes. Appellant then states that the addition of Akram to the rejection adds an additional laundry list of couplers to the choice one has in the selection of a suitable combination. The office respectfully disagrees with this analysis. The addition of Akram narrows the choice since Akram gives the particular motivation to select 2,6-bis(hydroxyethylamino)toluene from the list of couplers suggested by Lim in column 6 lines 17-24.

Appellant further argues that while it may be feasible to use the two claimed components in Lim's composition, there is no teaching that it would be desirable. This office respectfully disagrees with that statement. Lim teaches that the claimed base and coupler may be used in his disclosed hair dyeing compositions. If the combinations

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were not desirable, why would he suggest that they be used? All disclosures of the prior art, including non-preferred embodiment, must be considered. See *In re Lamberti and Konort*, 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328(CCPA 9173) All of the disclosures in a reference must be evaluated for what they fairly teach to one of ordinary skill in the art. *In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re Nehrenberg*, CCPA 1159, 280 F. 2d 161, 126 USPQ 383. Note M.P.E P. 2123, "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Heck*, 699 E.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843(Fed. Cir.) *cert. denied*, 493 U. S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Appellant is arguing working examples, not the entire disclosure.

Appellant further argues that neither Akram nor Lim provide express motivation to make the specific selection as claimed by appellant. In response to this argument, Lim teaches that both may be used together in oxidative hair dyeing compositions and Akram gives the motivation to select the specific coupler. See above. Several of the

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claimed substituted p-aminophenols claimed in applicant's independent claims are specifically included in those named in Lim.

Appellant's arguments regarding the rejection of the claims as unpatentable over **Lim in view of Akram further in view of Clausen** have been fully considered but they are not persuasive to overcome that rejection.

Appellant states that the rejection must fail because the combination of Lim and Akram is flawed. See above arguments. Appellant states that Clausen states that two of the presently claimed compounds provide comparatively weaker and blue shades than the standard p-aminophenol and that is a teaching away from their usage. The examiner disagrees. That statement shows that the color produced will be different from the red produced by p-aminophenol, and accordingly, one must not expect the same red shade that will be produced by p-aminophenol. However, they are perfectly equivalent for their intended purpose, that is us as an oxidative hair colorant, when a bluer shade of red is desired. The passage from Clausen shows that the claimed bases are well known, the color and depth of color of each base has been studied and catalogued, and they are equivalent for use in oxidative hair coloring systems.

Appellant next directs the Board's attention to examples 3 and 4 of the specification. Example 3 comprises an oxidation base outside of the scope of the independent claims, while example 4 comprises a base within the scope of the independent claims. This comparison does not present a comparison with the closest

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art, and it is also not commensurate in scope with the claimed subject matter.

Accordingly, it cannot be used to overcome a case of prima facie obviousness.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Margaret Einsmann
Primary Examiner
Art Unit 1751

Margaret Einsmann

September 14, 2004

Conferees

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